

**Application No.: 09/963,551**

**REMARKS**

Claims 2 and 8 are independent and stand rejected under 35 U.S.C. § 102 as being anticipated by Anderson '137 ("Anderson"). This rejection is respectfully traversed for the following reasons.

Claim 2 recites in pertinent part, "wherein image data ... is transferred from the image memory to the storage medium while *the* series of images is presented by the display" (emphasis added). Claim 8 similarly recites in method format, "temporarily storing the compressed image data on an image memory; ... storing the compressed image data successively on a storage medium while *the* series of images is presented on a display based on the image data stored on the display memory." It is respectfully submitted that Anderson is completely silent as to a transfer of the image data from the alleged image memory 532 to the alleged storage medium 354 while the series of images is presented by the alleged display 402.

In order to expedite prosecution, Applicants' representative initiated a telephone interview with Examiner Thompson. Applicants and Applicants' representative would like to thank Examiner Thompson for his courtesy in conducting the interview and for his assistance in resolving issues. A summary of the interview follows.

The Examiner argued that the claims, as currently recited, read broadly so that the claimed "series" can be interpreted as, for example, 10 frames in which frames 1-5 are being transferred while frames 6-10 are being displayed. In other words, the Examiner has taken the position that, in this example, the 10 frames can be read *collectively* as the claimed "series" notwithstanding the different timing for transfer and display. According to this interpretation, a subset of the alleged "series" would correspond to the series being transferred while a non-

**Application No.: 09/963,551**

overlapping *different* subset of the alleged "series" would correspond to the series being displayed.

However, as set forth during the interview, it is respectfully submitted that the claim language precludes such an interpretation. Specifically, the claims embody *the* series of images is presented by the display rather than *a* series of images. Accordingly, the "series of images presented by the display" refers back to the series of images being transferred; so that the series of images being transferred while being displayed would refer to a common overlapping set, rather than different subsets as would be required according to the Examiner's interpretation. Accordingly, it is respectfully submitted that a series of images as defined in the claims embodies images which are transferred while being displayed rather than images which are transferred than displayed at a later time. In this regard, using the example above, the "series" could read on either frames 1-5 (while being displayed) or frames 6-10 (while being transferred) but not frames 1-10 because none of frames 1-10 are being transferred while being displayed. Indeed, Applicants' specification supports the aforementioned interpretation of claims 2 and 8 (*see, e.g.,* page 12, lines 9-11 corresponding to Figure 3 of Applicants' drawings for one exemplary embodiment).

As anticipation under 35 U.S.C. § 102 requires that each and every element of the claim be disclosed, either expressly or inherently (noting that "inherency may not be established by probabilities or possibilities", *Scaltech Inc. v. Retec/Tetra*, 178 F.3d 1378 (Fed. Cir. 1999)), in a single prior art reference, *Akzo N.V. v. U.S. Int'l Trade Commission*, 808 F.2d 1471 (Fed. Cir. 1986), based on the forgoing, it is submitted that Anderson does not anticipate claims 2 and 8, nor any claim dependent thereon. The Examiner is directed to MPEP § 2143.03 under the

**Application No.: 09/963,551**

section entitled "All Claim Limitations Must Be Taught or Suggested", which sets forth the applicable standard for establishing obviousness under § 103:

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. (citing *In re Royka*, 180 USPQ 580 (CCPA 1974)).

In the instant case, the pending rejection does not "establish *prima facie* obviousness of [the] claimed invention" as recited in claim 3 because the proposed combination fails the "all the claim limitations" standard required under § 103. It is noted that Kuchta, relied on by the Examiner in the § 103 rejection against dependent claim 3, does not obviate the aforementioned deficiencies of Anderson.

Under Federal Circuit guidelines, a dependent claim is nonobvious if the independent claim upon which it depends is allowable because all the limitations of the independent claim are contained in the dependent claims, *Hartness International Inc. v. Simplimatic Engineering Co.*, 819 F.2d at 1100, 1108 (Fed. Cir. 1987). Accordingly, as claims 2 and 8 are patentable for the reasons set forth above, it is respectfully submitted that all claims dependent thereon are also patentable. In addition, it is respectfully submitted that the dependent claims are patentable based on their own merits by adding novel and non-obvious features to the combination.

Based on the foregoing, it is respectfully submitted that all pending claims are patentable over the cited prior art. Accordingly, it is respectfully requested that the rejections under 35 U.S.C. § 102/103 be withdrawn.

**CONCLUSION**

Having fully responded to all matters raised in the Office Action, Applicants submit that all claims are in condition for allowance, an indication for which is respectfully solicited. If

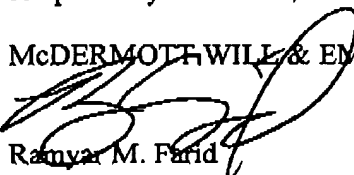
**Application No.: 09/963,551**

there are any outstanding issues that might be resolved by an interview or an Examiner's amendment, the Examiner is requested to call Applicants' attorney at the telephone number shown below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

McDERMOTT WILL & EMERY LLP

  
Ramyar M. Farid  
Registration No. 46,692

600 13<sup>th</sup> Street, N.W.  
Washington, DC 20005-3096  
Phone: 202.756.8000 RMF:MaM  
Facsimile: 202.756.8087  
Date: January 22, 2007

**Please recognize our Customer No. 20277  
as our correspondence address.**